# REMARKS

The Examiner is thanked for his Office Action of 03/12/2009. In response thereto, please consider the foregoing amendments and the following remarks. Claims 1-3, 5-8 and 11-22 are currently pending in this application and 1-3, 5-8 and 11-22 are currently rejected.

## Claim Rejections – 35 U.S.C. § 101

Claims 16-18 were rejected under 35 U.S.C. § 101 as not failing within one of the court statutory categories of invention. Applicant respectfully traverses. The Examiner is erroneously characterizing claims 16-18 as method claims when they are, in fact, article of manufacture claims. That is, the claim is for an electronic message comprising a data object stored on computer readable media and an application program object stored in a computer readable medium. Therefore, claims 16-18 are clearly directed to statuory subject matter and the Examiner is respectfully requested to withdraw his rejections.

## Claim Rejections – 35 U.S.C. § 112

Claims 15-22 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner indicate that the "computer readable medium is no existed [sic] in specification." Applicant respectfully traverses. The term "computer readable medium" is found in the preamble of original claim 15. It is well established that the original claims, as filed, form a part of an application specification.[1] Furthermore, since Applicant claimed a "computer readable medium" at the time of filing, it cannot be said that the Applicant did not "possess" that invention.

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[1] 35 U.S.C. §112, second paragraph, states that the "specification shall conclude with one or more claims particularly pointing out and disctinctly claiming the subject matter which the applicant regards as his invention." Under the plain language of this statute, originally filed claims are part of the "specification."

Examples of computer readable media can be found throughout Applicants specification and drawings. For example, Fig. 3 illustrates an exemplary hardware implementation showing a number of computer readable media such as Random Access Memory (RAM) 314, disk storage units 320, etc.

Applicant respectfully requests that the Examiner withdraw his rejection under 35 U.S.C. §112, first paragraph.

<u>Claim Rejections – 35 U.S.C. § 103</u>

Claims 1-2, 5-8, 11-13, 15-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,161,130 to Horvitz et al (herafter "Horvitz") in view of U.S. Patent No. 6,684,332 to Douglas (hereafter "Douglas"). Applicant respectfully traverses.

Independent claims 1, 15 and 16 are reproduced below:

> *1.      A method for executing an application program associated with an electronic message, comprising:*
> *<u>initializing at least one application program by automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user,</u> wherein the application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message, and wherein the <u>application program becomes associated with a context of the electronic message after being sent but before being received by the user;</u> and*
> *<u>automatically executing the application program of the electronic message within the context of the electronic message</u> after the initialization thereof. (emphasis added)*

> *15.      A computer program embodied in a computer readable medium for executing an application program associated with an electronic message, comprising:*
> *a segment at least partially within an electronic message for <u>initializing at least one application program by automatically retrieving code from a server over a network after the electronic message is received over the network and is opened for viewing by a user,</u> wherein the application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message, and wherein the <u>application program becomes associated with a context of the electronic message after being</u>*

*sent but before being received by the user;* and

a code segment *automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof. (emphasis added)*

16.     *An electronic message comprising:*

a data object including text that had been received over a network and stored in a computer readable medium on a computer having an electronic mail program; and

*an application program object initialized, at least in part, by being automatically received, at least in part, over the network after the receipt and opening for viewing of the data object,* the application program object being stored in a computer readable medium and *automatically executed on the computer after the initialization thereof,* and wherein the *application program becomes associated with a context of the electronic message after being sent but before being received by the user. (emphasis added)*

Applicant fails to see how emphasised claim limitations of independent claims 1, 15 and 16 are shown anywhere in the primary reference, Horvitz.  See, for example, col. 7, line 40 – col. 8, line 6:

*In actuality, identical messages may be sent by the sender to thousands of different recipients (if not more). However, for simplicity, we will only show one such recipient. At some point in time, that recipient stationed at client computer 100 will attempt to retrieve his (her) e-mail messages. To do so, that recipient (i.e., a user) will establish networked connection 70 to Internet 50 and execute client e-mail program 130--the latter being one of application programs 120 that resides on this computer. E-mail program 130 will then fetch all the mail for this recipient from an associated mail server (also not specifically shown) connected to Internet 50 that services this recipient. This mail, so fetched, will contain the unsolicited message originally transmitted by the sender. The client e-mail program will download this message, store it within an incoming message folder and ultimately display, in some fashion, the entire contents of that folder. Generally, these messages will first be displayed in some abbreviated manner so the recipient can quickly scan through all of his(her) incoming messages. Specifically, this will usually include, for each such message, its sender (if available), its subject (again if available) and, if a preview mode has been selected, a first few lines of the body of that message itself. If, at this point, the recipient recognizes any of these messages as spam, that person can instruct client e-mail program 130 to discard that particular message. Alternatively, if the recipient is interested in any of these incoming messages, (s)he can select that message,*

*typically by "clicking" on it, whereby the client e-mail program will display
the full body of that message. At that point, the recipient can also save the
message or discard it. Unless the recipient can identify an incoming
message, from just its abbreviated display, as spam, that person will
generally open this message, read enough of it to learn its nature and
then discard it. Horvitz. See, for example, col. 7, line 40 – col. 8, line 6*

There is no disclosure in Horvitz of <u>initializing at least one application program by</u> <u>automatically retrieving code from a server over a network after an electronic message</u> <u>received over the network is opened for viewing by a user</u>. There is no disclosure in Horvitz of an <u>application program becoming associated with a context of the electronic</u> <u>message after being sent but before being received by the user</u>. There is no disclosure in Horvitz of <u>automatically executing the application program of the electronic message</u> <u>within the context of the electronic message</u>. There is simply no overlap between multiple claim limitations of Applicant and the disclosure of Horvitz. Douglas does not cure the deficiencies of Horvitz. Independent claims 1, 15 and 16 and the claims dependent thereon are clearly patentable over Horvitz. The Examiner is respectfully requested to remove his rejections of claims 1-2, 5-8, 11-13 and 15-19.

Claims 3, 14 and 20-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz in view of U.S. Patent No. 6,651,087 of Dennis (6,651,087). Applicant respectfully traverses. It should be noted that all of these are dependent claims. Perhaps the Examiner intended to reject under the combination of Horvitz, Douglas and Dennis. In any event, as noted above Horvitz does not disclose a number of elements of independent claims 1, 15 and 16. Neither Douglas nor Dennis cure this deficiency. Claims 1, 15 and 16 are therefore patentable all combinations of Horvitz, Douglas and Dennis. The remaining pending claims, including but not limited to claims 3, 14 and 20-22 are dependent claims and are therefore patentable for at least the same reasons. The Examiner is respectfully requested to withdraw his rejection of claims 3, 14 and 20-22 under 35 U.S.C. 103(a).

<u>Conclusion</u>

Applicant believes that all pending claims are patentable for at least the forgoing reasons, and respectfully requests an early Notice of Allowance. Should the Examiner

believe that a telephone conference would expedite the prosecution of this application the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
TIPS Group

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